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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,420	07/18/2003	Anthony J. Baerlocher	01112300-1457	4074

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EXAMINER

NGUYEN, KIM T

ART UNIT PAPER NUMBER

3713

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/623,420

Applicant(s)

BAERLOCHER ET AL.

Examiner

Kim Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/18/03</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-54 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, 8, 15-17, and 22-23 of U.S. Patent No. 6,602,136. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-10, 12-21, 24-27, 29-41, 43-46, 49-50, and 52-54 disclose the same inventive feature in broader scope by eliminating the play activator. Further, claims 11, 22-23, 28, 42, 47-48, and 51 disclose well-known subject matter.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3-6, 11-12, 14-17, 22-23, 25-29, 31-33, 35-36, 39-44, 47-51, and 53-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lemay et al (US 2002/0010018) in view of Bennett (US Patent No. 6,102,798).

a. As per claim 1 and 3-6, Lemay disclose a game device comprising a plurality of paths 514a-514e (Fig. 5), each path includes a plurality of symbols 518a-518e (Fig. 5) associated with an outcome; a path change condition 518a (Fig. 5; lines 9-10 of [0031]); and a display device 512 (Fig. 5) for displaying objects as claimed ([0031]). Lemay does not explicitly disclose including a symbol marker. However, Bennett discloses displaying a marker (col. 3, lines 63-65). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement the marker of Bennett to the game device of Lemay in order to highlight the symbol the player selects.

b. As per claim 11, Lemay discloses receiving input through a network ([0025]).

c. As per claim 12, 14-17, and 22-23, refer to discussion in claims 1, 3-6 and 11 above.

d. As per claim 25-29 and 31, refer to discussion in claims 1, 3-4, 6 and 11 above.

e. As per claim 32-33, indicating the number of symbols a marker has moved to and displaying the indicator next to a path would have been well known to a person of ordinary skill in the art at the time the invention was made.

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f. As per claim 35-36, 39-44, 47-51, and 53-54, refer to discussion in claims 1, 3-4, 6, 22, 39, and 42 above.

5. Claims 2, 13, 24, 30, 37-38, 45-46, 52, are rejected under 35 U.S.C. 103(a) as being unpatentable over *Lemay et al* (US. Publication No. 2002/0010018) in view of *Bennett* (US Patent No. 6,102,798) and *Kamille* (US Patent No 5,996,997).

a. As per claim 2, Lemay does not explicitly disclose arranging symbols in a cyclical path. However, Lemay teaches arranging symbols in a specific arrangement would have been obvious (paragraph [0011]). Further, arranging symbols in a cyclical path would have been a known configuration as taught by Kamille in Fig. 6B. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to arrange symbols in the cyclical path of Kamille, since arranging symbols in a specific path requires only routine skill in the art as taught by Lemay in paragraph [0011].

b. As per claim 13, 24, 30, 37-38, 45-46, and 52, refer to discussion in claim 2 above.

Allowable Subject Matter

6. Claims 7-10, 18-21, and 34 would be allowable if rewritten to overcome the double patenting rejection set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter:

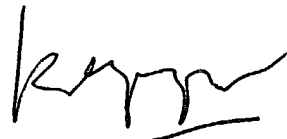
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Prior arts of record does not disclose a gaming device set forth in claims 1, 12, and 29 in which the symbol marker includes a graphical representation which indicates to the player how many symbols of the identical type the symbol marker has moved to.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is (703) 308-7915. The examiner can normally be reached on Monday-Thursday from 8:30AM to 5:00PM ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teresa Walberg, can be reached on (703) 308-1327. The central official fax number is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1148.



Kim Nguyen
Primary Examiner
Art Unit 3713

kn

Date: March 18, 2004